Remarks

Introduction

The above-identified application has been carefully reviewed in light of the Office Action mailed December 15, 2005, which included a final rejection of the pending claims. This Amendment includes a Petition for a Three-Month Extension of Time and is being submitted along with a Request for Continued Examination.

Claims 14-24 were pending. By way of this response, claims 14, 16, 18, 19, 21, and 23 have been amended, and claims 15, 17, 20, 22, and 24 have been cancelled without prejudice. Support for the amendments to the claims can be found in the application as originally filed, and no new matter has been added. Accordingly, claims 14, 16, 18, 19, 21, and 23 remain pending.

In view of the amendments to the claims and the remarks herein, applicant requests reconsideration and withdrawal of the objections and rejections.

Declaration

The Office Action requested a new oath or declaration because the declaration allegedly was defective for not identifying the mailing address of each inventor. As indicated in the Office Action, the mailing address may be provided in an application data sheet.

Enclosed herewith is a Supplemental Application Data Sheet in compliance with 37 CFR 1.76. The Supplemental Application Data Sheet properly identifies each of the inventors' residences

and mailing addresses (postal addresses). Deletions are indicated by strikethrough, and additions are indicated by underlining. In addition, the Supplemental Application Data Sheet includes the amended title that was amended in the Amendment submitted on September 28, 2004.

In view of the above, applicant submits that the objection to the declaration has been overcome, and applicant requests withdrawal of the objection.

Res Judicata

Claims 19 and 24 have been rejected on the grounds of *res judicata*.

Applicant does not concede to the correctness of the rejections. However, to advance the prosecution of the above-identified patent application, claim 19 has been amended as set forth above, and claim 24 has been cancelled.

The legal doctrine of *res judicata* does not apply if either: (a) the claims of the above-identified application are patentably different from the claims that were previously adjudicated; or (b) the claims in the above-identified patent application involve a different issue as compared to the claims that were previously adjudicated. See e.g. MPEP § 706.03(w).

Applicant submits that the present claims, that is claims 14, 16, 18, 19, 21, and 23, are directed to different methods than the claims that were before the Board of Patent Appeals and Interferences in it's decision 1997-2367. In that regard, each of the present claims is directed to the treatment of a specific

condition (e.g., dystonia or cervical dystonia) by administering specific amounts of botulinum toxin type A and botulinum toxin type E. Such methods were not addressed by the Board.

In view of the above, applicant submits that the doctrine of *res judicata* does not apply to the present claims, and applicant respectfully requests that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 14-24 has been rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being described in the specification in such a way as to convey that the inventors had possession of the claimed invention. Claims 14-24 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled by the specification. The Office Action acknowledges that the specification is enabling for using botulinum toxins to treat muscle spasms or dystonia.

Applicant does not concede with the correctness of the rejections. However, to advance the prosecution of the above-identified application, the present claims have been amended by replacing the language identified in the Office Action as a basis for the rejection under 35 U.S.C. § 112, first paragraph. For example, the present claims no longer recite "the immune response being selected from the group consisting of an allergic response, a delayed-type of hypersensitivity, a serum sickness-like response, and combinations thereof"; "less than about 300 units"; and "treat a neuromuscular disorder or condition selected from ... Parkinson's ...".

In addition, the present claims have been amended to recite the administration of botulinum toxins to treat dystonia, such as cervical dystonia, which is enabled by the specification, as acknowledged by the Office Action.

In view of the above, applicant submits that the present claims, that is claims 14, 16, 18, 19, 21, and 23, satisfy the requirements of 35 U.S.C. § 112, first paragraph, and respectfully requests that the rejections of the present claims based on this statutory provision be withdrawn.

Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 15-18 and 20-23 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for reciting "less than about" or "at least about". Claims 19-24 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for the recitation of "animus".

Applicant does not concede to the correctness of the rejections. However, to advance the prosecution of the above-identified application, the claims have been amended by deleting the phrases identified in the Office Action.

In view of the above, applicant submits that the claims satisfy the requirements of 35 U.S.C. § 112, second paragraph, and respectfully requests that the rejection of the present claims based on this statutory provision be withdrawn.

Rejections Under 35 U.S.C. § 103

Claims 19-24 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ludlow et al. (hereinafter Ludlow) in view of Simpson et al. (hereinafter Simpson) and Jankovic et al. (hereinafter Jankovic).

Applicant does not concede with the correctness of the rejections or remarks made in the Office Action. However, claims 14, 16, 18, 19, 21, and 23 have been amended as set forth above. Applicant traverses the rejections as they relate to the present claims.

Applicant submits that the combination of Ludlow, Simpson, and Jankovic does not disclose, teach, or suggest the present invention. For example, the combination of Ludlow, Simpson, and Jankovic does not disclose, teach, or even suggest a method for treating a dystonia or cervical dystonia which comprises administering up to 1,000 units of botulinum toxin type A, and administering up to 300 units of botulinum toxin type E after the subject experiences a loss of clinical response to the administered botulinum toxin type A, as determined by a failure of the administered botulinum toxin type A to achieve a marked reduction of or to substantially alleviate a symptom of the dystonia, as recited in the present claims.

Ludlow specifically discloses administration of botulinum toxin type F to patient having either torticollis, oromandibular dystonia, or stuttering, and having antibodies to botulinum toxin type A. Ludlow inferentially discloses that the patients received four times as much botulinum toxin type A compared to botulinum toxin type F in previous treatments. In other words,

the different patients received between 320 units and 5220 units of botulinum toxin type A, and between 80 units and 1305 units of botulinum toxin type F. However, importantly, the patient with oromandibular dystonia received 1440 units of botulinum toxin type A, and 360 units of botulinum toxin type F.

Simpson and Jankovic do not disclose, teach, or even suggest any amounts of botulinum toxin type E used in treatment protocols, let alone in treating dystonia or cervical dystonia.

Applicant maintains and resubmits here the remarks made in the response filed September 28, 2004 regarding the important distinctions between botulinum toxin type E and botulinum toxin type F which support the patentability of the present claims over the combination of Ludlow, Simpson, and Jankovic.

In addition, applicant submits that the combination of Ludlow, Simpson, and Jankovic does not disclose, teach, or even suggest the specific amounts of botulinum toxin types A and E recited in the present claims. For example, the combination of references do not include any disclosure or suggestion about administering up to 1000 units of botulinum toxin type A and up to 300 units of botulinum toxin type E to treat a dystonia, such as cervical dystonia. Simply put, the combination of references do not disclose, teach, or even suggest all of the elements recited in the present claims.

As acknowledged in the Office Action, Ludlow discloses amounts of botulinum toxin type F that were administered to the patients. However, as understood by persons of ordinary skill in the art, botulinum toxins are among the most lethal agents known to man. Applicant submits that due at least to the

dangerous nature of the botulinum toxins, a person of ordinary skill in the art would not be motivated to simply use the dosages of one botulinum toxin as the dosages of another botulinum toxin. This important feature is reflected in Ludlow who indicates that botulinum toxin type F was administered in a dose one quarter the size of the previously used dose of botulinum toxin type A. Thus, a person administering a botulinum toxin to a patient must be extremely careful in choosing an amount of a botulinum toxin to administer to a patient. A person of ordinary skill in the art would not be motivated to simply substitute the dosages of botulinum toxin type F and use those dosages for botulinum toxin type E, and there would be no reasonable expectation of success that one dose for a particular botulinum toxin would be useful for another different botulinum toxin.

Moreover, applicant submits that the combination of Ludlow, Simpson, and Jankovic does not disclose the administration of up to 1000 units of botulinum toxin type A and up to 300 units of botulinum toxin type E to treat a dystonia, such as cervical dystonia, as recited in the present claims. In contrast, Ludlow discloses administering more than 1000 units of botulinum toxin type A to treat a patient with dystonia, and more than 300 units of botulinum toxin type F to treat that patient with dystonia. Simpson and Jankovic do not disclose or even suggest administration of the amounts of botulinum toxin type A and type E as recited in the present claims. Thus, the combination of references do not disclose, teach, or even suggest the presently claimed methods, and in contrast, actually lead a person of ordinary skill in the art away from the presently claimed methods since Ludlow discloses using more botulinum toxin type

A, and more botulinum toxin type F, which is different and distinct from botulinum toxin type E.

In view of the above, applicant submits that the present claims, and independent claims 14 and 19 in particular, are unobvious from and patentable over Ludlow, Simpson, and Jankovic under 35 U.S.C. § 103.

In addition, each of the present dependent claims is separately patentable over the prior art. For example, none of the prior art disclose, teach, or even suggest the present methods including the additional feature or features, such as the dosages of botulinum toxin type A and botulinum toxin type E as recited in any of the present dependent claims. Therefore, applicant submits that each of the present claims is separately patentable over the prior art.

In conclusion, applicant has shown that the present claims are not subject to *res judicata*, satisfy the requirements of 35 U.S.C. § 112 and are not anticipated by and are unobvious from and patentable over the prior art under 35 U.S.C. §§ 102 and 103. Therefore, applicant submits that the present claims, that is claims 14, 16, 18, 19, 21, and 23 are allowable. In view of the above, applicant respectfully requests the Examiner to pass the above-identified application to issuance at an early date. Should any matters remain unresolved, the Examiner is requested to call (collect) applicant's attorney at the telephone number given below.

Respectfully submitted,

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